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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-------------------------|---------------------|------------------|
| 10/651,059 | 08/28/2003 | Dominic Anthony Viscomi | Viscomi-Viscomi | 9001 |
| 39570 | 7590 | 09/07/2005 | EXAMINER | |
| DOMINIC A. VISCOMI 1868 FELICITY LANE HELLERTOWN, PA 18055 | | | WILSON, JOHN J | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3732 | | |

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

S/P

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/651,059 | VISCOMI ET AL. | |
| | Examiner | Art Unit | |
| | John J. Wilson | 3732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 July 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 16-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims Renumbered

The amendment of July 29, 2005 cancels claims 1-17 and adds new claims 18-27, however, as originally filed, this application only contained claims 1-15, therefore, claims 1015 have been canceled and claims 18-27 have been renumbered to be claims 16-25.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 20 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 1, "said extrusion aperture" lacks antecedent basis within the claims. Claim 22 is redundant in view of claim 21. In claim 27, line 3, "its aperture" lacks antecedent basis within the claim, and "within its aperture" is unclear as to how the notch can be within an aperture.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tofflemire

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(2594367) in view of Tofflemire (2538486). Tofflemire (367) shows a dental matrix band having a boomerang shape, Fig. 2, hole 23 for aligning with a prepared surface of the tooth, Figs. 6 and 6. Tofflemire (367) shows only one hole, not holes. Tofflemire (486) shows using more than one opening 28 for aligning with inter-proximal surfaces. It would be obvious to one of ordinary skill in the art to modify Tofflemire (367) to include more than one hole as shown by Tofflemire (486) in order to fill all necessary areas.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tofflemire (2594367) in view of Tofflemire (2538486) as applied to claim 16 above, and further in view of Curran (1669231). Tofflemire (367) does not show using a notch in the periphery of the hole. Tofflemire (486) teaches using a break line 35 in the periphery of the aperture 28' in order to tear the band for removal. It would be obvious to one of ordinary skill in the art to modify Tofflemire (367) to include a break line in the periphery of the hole as shown by Tofflemire (486) in order to better tear the band for removal. The above combination shows a break line, not a notch. Curran teaches using a notch 20f. It would be obvious to one of ordinary skill in the art to modify the above combination to substitute a notch of Curran for the break line in order to use art known means for enabling separation of the band.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tofflemire (2594367) in view of Tofflemire (2538486) and Curran (1669231) as applied to claim 17 above, and further in view of Summer (6736639). The above combination does not show a superiorly located appendage. Summer shows locating the appendage superiorly of the

window. It would be obvious to one of ordinary skill in the art to modify the above combination to include a superiorly located appendage as shown by Summer in order to render the band easier to manipulate in use.

Claims 19, 20, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tofflemire (2538486) in view of Curran (1669231). Tofflemire (486) teaches a dental matrix having a general boomerang shape as shown with an aperture 28' for aligning with an interproximal surface of a tooth, and a break line 35 in the periphery of the aperture in order to tear the band for removal. Tofflemire (486) does not show using a notch. Curran teaches using a notch 20f. It would be obvious to one of ordinary skill in the art to modify the above combination to substitute a notch of Curran for the break line in order to use art known means for enabling separation of the band. The method of claim 27 is an obvious use of the shown structure.

Claims 21, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tofflemire (2538486) in view of Curran (1669231) as applied to claim 20 above, and further in view of Summer (6736639). The above combination does not show a superiorly located appendage. Summer shows locating the appendage superiorly of the window. It would be obvious to one of ordinary skill in the art to modify the above combination to include a superiorly located appendage as shown by Summer in order to render the band easier to manipulate in use. The method of claim 26 is an obvious use of the shown structure.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-31 of copending Application No. 10/457,168. Although the conflicting claims are not identical, they are not patentably distinct from each other because to use a boomerang shape and notches are obvious matters of choice in shape and known weakening means to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed July 29, 2005 have been fully considered but they are not persuasive. Using notches in place of a break line would be obvious to the skilled artisan as known equivalent ways to weaken a structure for tearing when desired.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
John J. Wilson
Primary Examiner
Art Unit 3732

jjw

September 3, 2005